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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,797	12/14/2001	Steven M. Bessette	45112-200	1638

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EXAMINER

AFREMOVA, VERA

ART UNIT PAPER NUMBER

1651

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/014,797

Applicant(s)

BESSETTE ET AL.

Examiner

Vera Afremova

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 July 0205.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,7,17,20 and 140-145 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,7,17,20 and 140-145 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/13/2005 has been entered.

Claims 1, 7, 17, 20 and 140-145 as amended ( 5/09/2005) are pending and under examination in the instant office action.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 7, 17 and 20 as amended remain rejected under 35 U.S.C. 102(b) as being anticipated by DE 524 383 in view of Merck (Encyclopedia of chemicals, drugs and biologicals. 1996).

Claims are directed to a pesticidal composition comprising a carrier and a pesticidally active ingredient that consists of rosemary oil and wintergreen oil. Some claims are further drawn to the use of carriers selected from mineral oil, citronellal and/or limonene. Some claims are directed to the use of equal amounts of rosemary and wintergreen oils in the composition.

DE 524 383 teaches a pesticidal composition for combating cockroaches, bugs, etc. (see English abstract and official translation pages 2-3) wherein the composition comprises pesticidally acceptable carriers and a pesticidally active ingredient that consists of rosemary oil and wintergreen oil in equal amounts. The composition of the cited patent comprises equal amounts of rosemary oil (34 g) and wintergreen oil (34 g), for example: see col. 1, lines 27 and 30; see translation pages 2-3. The list of carriers includes mineral oil (petroleum) and lemon oil that comprises citronellal and/or limonene. The citronellal and limonene are found in lemon oil in view of Merck disclosure (pages 393 and 938).

The cited patent is considered to anticipate the claimed invention as amended because it discloses an identical composition comprising at least 2 major components that are 1) carrier(s) and 2) pesticidally active ingredient consisting of equal amounts of rosemary oil and wintergreen oil. The fact that the cited patent DE 524 383 discloses the use of some additional components including oils, carriers and/or solvents does not distinguish the referenced composition from the presently claimed composition because the claimed composition is open to incorporation of additional carries and/or active ingredients by the virtue of open language “comprising”. The additional components in the cited patents are oils, solvents, emollients, bases for aromatic compounds and subcomponents of the presently claimed “carriers”. For example: linseed oil is used as emollient and, thus, it is not different from a generic pesticidally acceptable carrier as claimed; spirits and caustic potash solution (KOH) are solvents and, thus, they are not different from a generic pesticidally acceptable carrier(s) as claimed; benzene is naturally occurring in mineral oil and, thus, it is either present in the claimed mineral oil or it is not different from a generic pesticidally acceptable carrier as claimed; anisol and pinene (turpentine oil) are used as

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bases for aromatic compounds and, thus, they are not different from a generic pesticidally acceptable carrier as claimed; benzylaldehyde is used as solvent and, thus, it is not different from a generic pesticidally acceptable carrier as claimed; although trichloroacetic acid, phenol and formaldehyde might be used as antiseptics or antimicrobials, they are also solvents and, thus, acceptable as pesticidal carriers.

Therefore, the additional components besides rosemary and wintergreen oils in the composition the cited patent fall within the meaning of the presently claimed "pesticidally acceptable carrier". Moreover, the claimed carrier(s) including mineral oil, citronellal and limonene are oils and oil derivatives.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 7, 17, 20 and 140-145 as amended and new claims 140-145 remain/are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 524 383 taken with Merck, the references by Inazuka et al. (1982a), Watanabe et al., US 4,379,168 (Dotolo), US 6,004,569 (Bessette et al) and US 5,496,857 (Targosz).

Claims are directed to a pesticidal composition comprising a carrier and a pesticidally active ingredient that consists of rosemary oil and wintergreen oil. Some claims are directed to the use of equal amounts of rosemary and wintergreen oils in the composition. Some claims are further drawn to the use of carriers selected from mineral oil, benzyl alcohol, citronellal, limonene, safflower oil, soybean oil and/or sesame oil.

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The cited patent DE 524 383 is relied upon as explained above. The references by Inazuka et al. and by Watanabe et al. are relied upon as explained in the prior office action for the disclosure of pesticidal compositions comprising pesticidally effective amounts of either rosemary oil or wintergreen oil alone. The cited documents disclose the use of various carriers or diluents in pesticidal compositions including mineral oil (DE 524 383) or citronellal (see Watabe et al. at table II) or limonene and citronellal as components of lemon oil (DE 524 383 in view of Merck). But they are missing the particular disclosure related to the use of pesticidally acceptable carriers such as benzyl alcohol, safflower oil, soybean oil and sesame oil.

However, the following documents are relied upon for the missing disclosure. For example: US 5,496,857 teaches safflower oil, soybean oil, sesame oil and also mineral oil as carriers and/or synergistic components in pesticidal mixtures (col. 2, lines 10-20, 43, 47, 55, 63 and 65). US 4,379,168 teaches benzyl alcohol and citronellal as components of pesticidal mixtures (col. 3, lines 40-44 and line 60; col. 4, line 35). US 6,004, 569 teaches the use of d-limonene as component of pesticidal mixtures.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to add or to substitute at least one acceptable carrier(s) into the composition of the cited DE 524 383 with a reasonable expectation of success in combating pests including various insects because all components that are presently claimed have been known and used in pesticidal mixtures as acceptable carriers and/or synergistic diluents as demonstrated by the all cited references including cited documents Inazuka et al. (1982a), Watanabe et al., US 4,379,168 (Dotolo), US 6,004,569 (Bessette et al) and US 5,496,857 (Targosz). It is well known that it is prima facie obvious to combine two or more ingredients each of which is taught by the

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prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); In re Crockett, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960). Thus, the claimed invention as a whole was clearly prima facie obvious, especially in the absence of evidence to the contrary.

Thus, the claimed subject matter fails to patentably distinguish over the state art as represented by the cited references. Therefore, the claims are properly rejected under 35 USC § 103.

### ***Response to Arguments***

Applicants' arguments filed 5/10/2005 have been fully considered but they are not persuasive.

With respect to the cited DE 524383 applicants argue (response page 5, par. 2) that it does not disclose each and every element of the claimed invention. Yet, applicants do not point what elements and/or components are missing in the cited composition. The claimed composition is open to incorporation of both various carrier(s) and various active ingredient(s) by the virtue of open language "comprising". In alternative, the claimed citronellal and limonene are "active ingredient(s)" but not the carrier(s) and, therefore, claimed invention appears to extend than further limit the claimed "active ingredient" that "consist of" only 2 ingredients.

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With regard to claim rejection under 35 USC § 103 applicants argue that Inazuka et al. and Watanabe et al. teach rosemary oil and wintergreen oil as insect repellants rather than pesticidally active ingredients. This arguments are not found convincing because at the very least the differences are uncertain as argued and as claimed. Inazuka et al. and Watanabe et al. teach and suggest rosemary oil and wintergreen oil for combating and/or controlling insect. The term “pesticide” is used by applicants as a substance intended to control pests including insects (specification page 5, line 10).

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicants' arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which they think the claims present in view of the state of the art disclosed by the references cited. Further, they do not show how the amendments avoid such references.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vera Afremova whose telephone number is (571) 272-0914. The examiner can normally be reached from Monday to Friday from 9.30 am to 6.00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached at (571) 272-0926.



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The fax phone number for the TC 1600 where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Vera Afremova

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August 15, 2005

A handwritten signature in black ink, appearing to read 'V. Afremova', with a long horizontal flourish extending to the right.

VERA AFREMOVA

PATENT EXAMINER